Attorney Docket No. YOR920000048US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

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Signature: _____ Date: August 14, 2006

Applicant(s): P.T. Keyser et al.
Docket No.: YOR920000048US1
Serial No.: 09/624,963
Filing Date: July 25, 2000
Group: 2178
Examiner: Kyler Stork

Title: Methods and Apparatus for Automatic Page Break Detection

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TRANSMITTAL OF REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is the following document relating to the above-identified patent application:

(1) Reply Brief.

It is believed that there is no additional fee due in conjunction with the response. In the event of any non-payment or improper payment of a required fee, the Commissioner is hereby authorized to charge or to credit **International Business Machines Corporation Deposit Account No. 50-0510** as required to correct the error.

Respectfully submitted,

Date: August 14, 2006

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REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants (hereinafter referred to as "Appellants") submit this Reply Brief under 37 C.F.R. §1.193(b)(1) in response to the Examiner's Answer mailed on June 14, 2006 relating to the Supplemental Appeal Brief filed by Appellants on May 8, 2006 appealing the final rejection of claims 1-4, 11, 19 and 23-25 of the above-identified application.

ARGUMENT

In the Examiner's Answer, the Examiner reiterates that: (i) claims 1-4 , 24 and 25 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,128,633 to Michelman et al. (hereinafter "Michelman") in view of U.S. Patent No. 5,838,819 to Ruedisueli et al. (hereinafter "Ruedisueli); (ii) claim 11 is unpatentable under 35 U.S.C. §103(a) over Michelman in view of Ruedisueli and further in view of U.S. Patent No. 6,502,114 to Forcier (hereinafter "Forcier") and U.S. Patent No. 5,911,146 to Johari et al. (hereinafter "Johari"); (iii) claim 19 is unpatentable under 35 U.S.C. 103(a) over Michelman in view of Ruedisueli and in further view of U.S. Patent No. 5,805,118 to Mishra et al. (hereinafter "Mishra"); and (iv) claim 23 is unpatentable under 35 U.S.C. 103(a) over Michelman in view of Ruedisueli, Forcier and Johari and in further view of U.S. Patent No. 5,909,221 to Nakai et al. (hereinafter "Nakai").

At pages 3 through 9, the Examiner's Answer appears to repeat, *verbatim*, the rationale for rejecting the claims from the final Office Action dated April 5, 2004.

At pages 9 through 13, entitled "Response to Arguments," the Examiner's Answer appears to repeat, *verbatim*, the response from first Examiner's Answer mailed on June 2, 2005, which appeared to attempt to address the traversal arguments raised by Applicants in their original Appeal Brief filed October 12, 2004. Note that a Supplemental Appeal Brief was filed at the request of the Board for formatting reasons.

However, the present Examiner's Answer again fails to address all of Applicants' arguments. In addition, the Examiner's Answer raises some new points with which Applicants strongly disagree. These issues will now be addressed.

The Examiner's Answer at pages 9-10 states:

> In claim 1, the applicant indicates inserting one or more page breaks in the electronic document and also maintaining page correspondence between an electronic and a physical document in a handwriting system, however, it is unclear weather [sic] the asynchrony of the pages are electronic and physical pages that are related. The claim does not explain what is meant by asynchrony.

As stated in the Supplemental Appeal Brief at page 6, Appellants argue that the Michelman/Ruedisueli combination fails to teach or suggest "automatically identifying, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page," as in the claimed invention.

Thus, the claim expressly indicates that one or more potential page breaks are automatically identified for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page. Appellants therefore do not understand how it could be asserted that "[t]he claim does not explain what is meant by asynchrony," as is asserted in the Examiner's Answer, since the claim expressly refers to maintaining a page correspondence between the electronic document and

a physical document . . . so as to at least partially reduce asynchrony between an electronic page and a physical page.

Furthermore, as stated in the Supplemental Appeal Brief beginning at page 6, the present specification explains, at page 1, line 15, through page 2, line 2:

> [In accordance with existing techniques,] . . . to maintain . . . accurate correspondence between the physical page and the electronic copy, the writer is required to "turn" the electronic page when changing to a new or previous paper page by pressing the corresponding page-forward or page-backward button on the PDN [personal digital notepad]. These buttons effect synchrony between the physical and electronic page by recording these events in the data stream. Asynchrony between the paper and electronic pages occurs when a writer forgets to press the appropriate button on the device or accidentally presses the button too many times. Subsequent writing is then electronically recorded on the wrong electronic page, and the new electronic ink is recorded on top of the page's original electronic ink. This problem may be compounded since the user may flip forward or backward by several pages at a time and may do so several times within a single document. Later, when the resultant electronic page is viewed, the merged original and overwritten electronic ink can be confusing and may be difficult to read and correct.

To address this problem, the claimed invention automatically identifies, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page.

A key aspect with respect to the claimed invention is that the potential page breaks are automatically identified. So, even if a writer forgets to press the appropriate button on the device or accidentally presses the button too many times, causing asynchrony between the paper and electronic pages, the claimed invention automatically identifies, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page.

Michelman has nothing to do with handwriting systems and, therefore, does not address the unique electronic/physical page asynchrony problem associated with handwriting systems. However, while Ruedisueli relates to handwriting systems, it does not address the problem that the

claimed invention addresses. That is, while Ruedisueli explains that page identifiers (36) are manually entered in the upper right hand corner of a page to set the page number (column 4, lines 46-56 of Ruedisueli) and to change the page number (column 5, lines 26-40 of Ruedisueli), there is no teaching of automatically identifying, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page, as in the claimed invention.

Thus, while Ruedisueli illustrates a user signaling a page change, the problem is that this manual signaling could be wrong, or the user could just forget to manually signal a page change, resulting in the above-described asynchrony problem. Ruedisueli provides no solutions for this problem. Also, while Michelman mentions allowing a user to select a page break via a graphical user interface and then adjusting the page breaks for the remainder of a document, again, the initial selection is still a manual process, not an automated process. Thus, the cited combination fails to teach or suggest the automated identification operation of the claimed invention.

The final Office Action, and now the Examiner's Answer, fails to address this claim limitation.

Next, the Examiner's Answer at page 10 states:

> It is also well known in the art that word processors as well as hand written pen-based text can be used for text data. It is well known that both environments can be introduced in identifying page breaks.

Appellants are not completely certain of the relevance of this statement. To the degree that the statement is intended to show some motivation to combine Michelman and Ruedisueli, Appellants assert that this is not proper motivation to combine the references, as will be further reiterated below. To the degree that the statement suggests rationale for why the Examiner continues to assert that Ruedisueli teaches the automated identification operation of the claimed invention, Appellants strongly disagree for the reasons given in the Supplemental Appeal Brief and reiterated above.

Next, the Examiner's Answer at page 10 states:

> The applicant argues that the prior art does not mention that the potential page breaks are not [sic] automatically identified (Page 7 Para 1-3). However, in Michelman, a system process performs the steps of moving the selected page break to the new location and adjusting the scaling and the automatic page-breaks for the remainder of the document to accommodate the page break at the new location. (Michelman Abstract)

As mentioned above, a key aspect with respect to the claimed invention is that the potential page breaks are automatically identified. Again, even if a writer forgets to press the appropriate button on the device or accidentally presses the button too many times, causing asynchrony between the paper and electronic pages, the claimed invention automatically identifies, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page. This is clearly not the case with Michelman, wherein the Michelman technique operates after the user manually selects a page-break within the electronic document and then manually identifies a new location for the page-break (see Michelman Abstract).

Furthermore, the Examiner's Answer at page 10 states:

> Regarding claims 1, 24 and 25 Applicant argues that there is a lack of motivation as to why Michelman would be combined with Ruedisueli (Page 4 Para 6 and 7). Michelman would be motivated to add to the electronic notepad, which includes devices operatively connected to the electronic notepad for operating with the electronic notepad to receive, manage, merge, and/or display the electronic copies from the electronic notepad as taught by Ruedisueli Abstract Lines 8-12 to automatic page break pagination which performs the steps of moving the selected page break to the new location and adjusting the remainder of the document to accommodate the page-break at the new location as taught by Michelman Col 4 Lines 45-49.

This above statement still fails to support the rationale to combine, since it simply states that something alleged about Michelman could be added to something alleged about Ruedisueli without stating why one would add the two together.

As stated in the Supplemental Appeal Brief at pages 4 and 5, a proper case of obviousness has not been established. Michelman is directed to a method of manipulating page breaks in documents created in accordance with standard word processing and spreadsheet applications such

as Microsoft Word and Excel (see columns 1 and 2 of Michelman), while Ruedisueli is directed to a method of processing electronic copies of handwritten notes . That is, the teachings in each reference are directed to completely different environments; one (Michelman) toward standard word processing and spreadsheet applications, the other (Ruedisueli) toward a handwritten note processing environment. Thus, while Ruedisueli is related to a handwriting system, Michelman has nothing to do with a handwriting system. However, other than a very general and conclusory statement in the final Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these two references.

To further reiterate, the Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

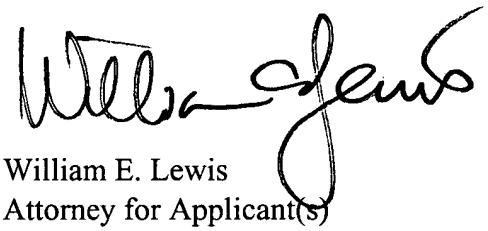
All of the Examiner's statements to date are based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, other than citing disparate portions of each of the references, the Examiner fails to identify any objective evidence of record which supports the proposed combination. That is, there is no objective support given for why one would be motivated to modify techniques (Michelman) that have nothing to do with a handwriting system to include techniques associated with a handwriting system (Ruedisueli).

As mentioned above, to the degree that the Examiner's statement at page 10 of the Examiner's Answer ("It is also well known in the art that word processors as well as hand written pen-based text can be used for text data. It is well known that both environments can be introduced in identifying page breaks.") is intended to support motivation to combine the references, Appellants do not see how such a statement serves as objective support for why one would be motivated to modify techniques (Michelman) that have nothing to do with a handwriting system to include techniques associated with a handwriting system (Ruedisueli).

Pages 10 through 13 of the Examiner's Answer with regard to claims 2-4, 11, 19 and 23 appear to be nothing other than a further repeat of the rationale offered in the final Office Action and repeated once already at pages 5 through 9 of the Examiner's Answer.

For at least the reasons given above and in the Appeal Brief, it is asserted that appealed claims 1-4, 11, 19 and 23-25 are patentable over the cited references.

Respectfully submitted,



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